

BS00097 CIP 2

U.S. Application No. 10/801,222 Examiner CHOW, Art Unit 2645  
Response to October 5, 2005 Office Action

### **REMARKS**

In response to the Office Action dated October 5, 2005, the Assignee respectfully requests reconsideration based on the following remarks. The Assignee respectfully submits that the pending claims already distinguish over the cited documents.

The United States Patent and Trademark Office (the "Office") rejected claims 1-4, 10-12, 14-16, and 18-21 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,757,898 to Ilse *et al.* Claim 5 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Ilse. Claims 6 and 13 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Ilse in view of U.S. Patent 6,438,217 to Huna. Claims 7 and 17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Ilse. Claim 12 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Ilse in view of U.S. Patent 6,738,784 to Howes.

Claims 8 and 9, however, were not clearly explained. The office action states "[r]egarding claims 8 and 9, see column 2 line 37-39." No other explanation is given, nor are any documents cited. The Assignee asks Examiner Chow to provide a fuller explanation.

Regardless, the pending claims are neither anticipated nor obviated. As the following paragraphs explain, the pending claims all recite features not taught or suggested by any cited documents. The respective § 102 and § 103 rejections, therefore, must be withdrawn.

### **Amendment of the Claims**

Independent claims 14, 20, and 21 are amended. These claims, however, are only amended for clarification. These claims are not amended to overcome cited documents. Because independent claim 1, in its original form, also distinguishes over the cited documents, Examiner Chow has no cause for a final rejection in the next office action.

### **Rejections under 35 U.S.C. § 102**

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The Office rejects claims 1-4, 10-12, 14-16, and 18-21 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,757,898 to Ilsen *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, the pending claims already distinguish over *Ilsen*. The reference to *Ilsen* does not anticipate the claims, so the Assignee respectfully requests that Examiner Chow to remove the 35 U.S.C. § 102 (e) rejection.

Exemplary embodiments describe communications services. A subscriber is allowed to create a data message and associate the data message to an originating party and to a recipient. When a communication is received from the originating party, the data message is then communicated to the recipient via an Internet Protocol communications network. Claim 1, for example, is reproduced below.

[c01] (Original) A method of providing communications services, comprising the steps of:

- allowing a subscriber to create a data message;
- allowing the subscriber to associate the data message to an originating party and to a recipient;
- receiving a communication from the originating party; and
- communicating the data message to the recipient via an Internet Protocol communications network.

Independent claims 14, 20, and 21 are similar. These claims "[allow] a first party to compose a data message" and "to associate that data message with a second party and with a third party." When a communication is received "from the second originating party," the data message is communicated "to the third party recipient." A "clean" version of claim 14 is reproduced below, and independent claims 20 and 21 recite similar features.

[c14] A method of providing communications services, comprising the steps of:

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storing a user interface in memory, the user interface allowing a first party to compose a data message and to associate that data message with a second party and with a third party;

receiving a communication from the second party; and  
communicating the data message to the third party.

The reference to *Ilсен* does not anticipate the claims. It's important for Examiner Chow to realize that all the independent claims recite three (3) different parties: a subscriber (or first party), an originating party (or second party), and a recipient (or third party). The patent to *Ilсен*, however, fails to teach or suggest such features. *Ilсен* only teaches communication(s) between a patient and their physician. *Ilсен* fails to describe a third party. See, e.g., U.S. Patent 6,757,898 to *Ilсен et al.* (Jun. 29, 2004) at column 4, lines 5-8; at column 6, lines 62-66; at column 7, lines 1-13 (especially lines 5-8); at column 8, lines 5-7; at column 8, lines 18-20; at column 8, lines 21-23; at column 10, lines 29-32; at column 10, lines 38-39; and at column 11, lines 64-66. *Ilсен* also provides a detailed example of communications between a patient and their physician at column 13, line 20 through column 14, line 56. Because *Ilсен* fails to disclose all the features of the claims, the § 102 rejection, therefore, must be removed.

Moreover, *Ilсен* emphasizes this direct provider-patient communication. Numerous times *Ilсен* describes direct provider-patient communications. See, e.g., U.S. Patent 6,757,898 to *Ilсен et al.* (Jun. 29, 2004) at column 4, lines 5-8; at column 6, lines 62-66; at column 7, lines 1-13 (especially lines 5-8); at column 8, lines 5-7; at column 8, lines 18-20; at column 8, lines 21-23; at column 10, lines 29-32; at column 10, lines 38-39; and at column 11, lines 64-66. *Ilсен* also explains that direct provider-patient communications are trusted by patients (see column 9, lines 50-53) and provide privacy (see *id.* at lines 65-67). No where does *Ilсен* make any description of three (3) different parties (e.g., subscriber or first party, an originating party or second party, and a recipient or third party), as the independent claims recite. The § 102 rejection must, therefore, be withdrawn.

**Rejection of Claim under § 103 (a)**

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The dependent claims are not obvious. Claim 5 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Ilse*n. Claims 6 and 13 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Ilse*n in view of U.S. Patent 6,438,217 to Huna. Claims 7 and 17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Ilse*n. Claim 12 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Ilse*n in view of U.S. Patent 6,738,784 to Howes.

If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). These dependent claims, however, all depend from their respective base claims and, thus, incorporate the same distinguishing features. Because any combination of *Ilse*n, *Huna*, and *Howes* remains completely silent to these features, the § 103 rejection of these dependent claims must be withdrawn.

#### Claims 8 and 9

Claims 8 and 9, however, were not sufficiently rejected. The office action fails to cite a statutory rejection, and the office action fails to provide a clear explanation of any rejection. The office action only states "[r]egarding claims 8 and 9, see column 2 line 37-39." No other explanation is given, nor are any documents cited. The Assignee respectfully asks Examiner Chow to provide a fuller explanation.

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@wzpatents.com](mailto:scott@wzpatents.com).

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized, overlapping loop structure.

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